



PATENT
Attorney Docket No.: A-71138-1
File No. 468488-00214

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

MAYO *et al.*

Serial No. 10/074,679

Filed: February 11, 2002

For: *Methods for the Generation of
Proteins with New Enzymatic
Function*

Examiner: BORIN, Michael L.

Art Unit: 1631

Confirmation No.: 9173

CERTIFICATE OF MAILING

I hereby certify that this correspondence, including listed enclosures, is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on:

Dated: September 18, 2006

Signed: Timothy A. Worrall
Timothy A. Worrall

PETITION UNDER 37 C.F.R. § 1.181

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.181, Applicants respectfully Petition the Notice of Non-Compliant Amendment mailed May 16, 2006.

Applicants filed claims 28-36 on February 1, 2006. On May 16, 2006, the Examiner issued a notice of non-compliant/non-responsive amendment. Applicants respectfully submit that the Examiner's Notice of is non-compliant/non-responsive amendment is erroneous, and request Examination of withdrawn claims 28-36.

Pending claim 28, like originally examined claim 1 filed on March 11, 2004, is directed to a "method of screening for protozymes." In the communication dated May 16, 2006, the Examiner stated that the new set of claims is directed to "a method which is related but patentably distinct" from the previously pending clams. Specifically, the Examiner argues that amending the claims to recite "high-energy state rotamers" takes the pending claims outside the scope of claimed subject matter that which was originally examined.

The claim term "high-energy state rotamers" was in originally filed claim 5. Originally filed claim 5 recites "[a] method according to claim 1 wherein said insertion step comprises the use of at least one high energy state rotamer." (Emphasis added.) Applicants incorporated the limitation of claim 5 into claim 28 in reciting a step of "inserting an active site domain into said

scaffold comprising the use of one or more high energy state rotamers. (Emphasis added.)

The term "high energy state rotamers" was thus incorporated directly into the independent claim from originally pending claim 5. Step (d) is further directed to how the "high-energy rotamers" are used in subsequent method steps. Claim 28 is directed to originally examined subject matter.

Applicants note that claim 5 was not restricted from claim 1 during prosecution.

The Commissioner is authorized to charge the requisite fee pursuant to 37 C.F.R. §1.181, or credit any overpayment to Deposit Account No. 50-2319 (File No. 468488-00214; Docket No. A-71138-1).

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: September 18, 2006

Customer Number: 32940

Dorsey & Whitney LLP

555 California Street, Suite 1000

San Francisco, CA 94104-1513

Telephone: (415) 781-1989

Facsimile: (415) 398-3249

By:



Timothy A. Worrall, Reg. No. 54,552 for
Robin M. Silva, Reg. No. 38,304



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Dated: September 18, 2006

Signed: *Tim Worrall*
Tim Worrall

PETITION FOR EXTENSION OF TIME

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §1.136(a), an extension of three (3) months is hereby requested in response to the Notice of Non-Compliant Amendment mailed May 16, 2006. The Commissioner is authorized to charge the requisite fee pursuant to 37 C.F.R. §1.17 of \$510.00, and any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-2319 (File No. 468488-00214; Docket No. A-71138-1).

Respectfully submitted,

DORSEY & WHITNEY LLP

By:

Timothy A. Worrall
Timothy A. Worrall, Reg. No. 54,552 for
Robin M. Silva, Reg. No. 38,304

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Customer Number: 32940
Dorsey & Whitney LLP
555 California Street, Suite 1000
San Francisco, CA 94104-1513
Telephone: (415) 781-1989
Facsimile: (415) 398-3249

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